

REMARKS

Claims 1-11 are all the claims pending in the application. Claims 1-11 are rejected under the judicially created doctrine of obviousness type double patenting. Claims 1-11 are also rejected under 35 U.S.C. § 103.

Priority

At page 2 of the Office Action, the Examiner asserts that the present divisional application “should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.”

Applicants respectfully disagree with the Examiner. Applicants submit that the MPEP merely sets forth that applicants may amend the specification when filing a divisional application, and that the divisional application “should set forth *at least* that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.” *See* § 201.6 in the MPEP, rev. 2, May 2004 (emphasis added). Furthermore, the Examiner appears to be relying on an outdated form paragraph in the previous version of the MPEP. Thus, Applicants submit that Applicants are not required to amend the specification in the manner prescribed by the Examiner.

Rejection under Obviousness-type Double Patenting

The Examiner has rejected Claims 1-11 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-12 of U.S. Patent No. 6,638,702 to Sato, et al. (“Sato ‘702”), in view of U.S. Patent No. 5,792,601 to Edwards, et al. (“Edwards ‘601”).

Applicants submit a Terminal Disclaimer in response thereto. Therefore, it is respectfully requested that the rejection be withdrawn.

Claims 1-11 rejected under 35 U.S.C. § 103

The Examiner has rejected Claims 1-11 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,783,373 to Mydlarz, et al. ("Mydlarz '373") or U.S. Patent No. 5,783,378 to Mydlarz, et al. ("Mydlarz '378"), in view of Edwards '601.

It is asserted by the Examiner that one of ordinary skill in the art would have modified the silver halide grains described in Mydlarz '373 and Mydlarz '378 so that the grains would have a high iodochloride region and doped silver bromide epitaxial deposit region as described in Edwards '601.

Applicants note that Mydlarz '373 in column 14, lines 47-63, describes that the silver halide grains thereof optimally contain at least 90 mole percent chloride, based on silver; and can contain silver bromide and silver iodochloride. Furthermore, Applicants note that Mydlarz '373 in its Abstract describes that the dopants and a gelatino-peptizer function together to provide for an increase in contrast.

As described on page 4 of the Action, Edwards '601 describes a silver halide grain comprising a silver iodochloride region and silver bromide region. The silver halide grain thereof is produced by adding an epitaxy to a silver iodochloride host grain. Edwards '601 discloses that the epitaxy thereof contains iridium and silver bromide. The Abstract of Edwards '601 describes that the emulsions thereof provide acceptable photographic characteristics, increased speed and an increase in contrast.

Accordingly, it seems that both emulsions described in Edwards '601 and Mydlarz '373 attempt to improve contrast. It also seems that Mydlarz '373 in column 14, lines 47-63, describes that its emulsion can contain silver chloride, silver bromide, and silver iodochloride in

no particularly organized form. Therefore, although the Examiner fails to explicitly refer to the descriptions recited in column 14 of Mydlarz '373, it appears that the rejection is grounded on the teachings that both emulsions increase contrast and contain silver chloride, silver bromide, and silver iodochloride.

Applicants' Response

Applicants respectfully submit that the presently claimed silver halide emulsion is not rendered obvious by the cited prior art. Specifically, Applicants submit that the Examiner applies impermissible hindsight reasoning in rejecting Claims 1-11.

As noted in the case law, it is the essence of hindsight to take the inventor's disclosure as a blueprint for piecing together the prior art in order to defeat patentability. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

With regard to the present case, Applicants submit that there would have been no basis for one of ordinary skill in the art to incorporate the high iodide chloride region and the bromide epitaxial deposit described in Edwards '601 into the emulsion of Mydlarz '373.

Applicants respectfully assert that one of ordinary skill in the art would not be motivated to choose the specific forms described in Edwards '601 based on the general descriptions of Mydlarz '373.

For example, Mydlarz '373 discloses that class (iii) dopants, which correspond to Ir dopants, are preferably introduced into a central portion (*i.e.*, an interior shell region) of the silver halide grains. *See* Mydlarz '373, column 13, last paragraph to column 14, first paragraph.

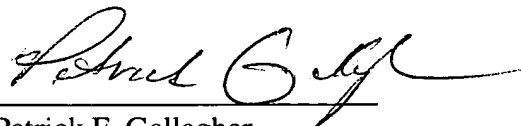
In addition, Mydlarz '373 also discloses that epitaxy is not contained in the silver halide grains. *See* Mydlarz '373, column 15, last paragraph to column 16, first paragraph.

Accordingly, one of ordinary skill in the art would not have been motivated to incorporate the above-identified teaching of Edwards, *i.e.*, to dope Ir in "epitaxy," since Mydlarz '373 excludes "epitaxy" from the doping site of the metal complex. Thus, it is respectfully submitted that the § 103 rejection of Claims 1-11 be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Patrick F. Gallagher
Registration No. 54,109

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: December 21, 2004